

**REMARKS**

This paper is in response to the Office Action of June 14, 2002. This response is timely filed, as it is accompanied by a petition for automatic extension of time to file in the second month and the requisite petition fee.

Claims 1-25 were pending prior to this amendment. By this amendment, applicants cancel claims 1-25. Further, by this amendment, applicants add claims 26-48. Consequently, claims 26-48 are presently pending.

By this amendment, applicants cancel the "SUMMARY OF INVENTION," and substitute a statement concurrent with the claims as presently pending. Applicants submit that this is in keeping with 37 C.F.R. §1.73, which states that "Such summary should, when set forth, be commensurate with the invention as claimed . . . ." Applicants also amend the paragraph beginning at page 8, line 3 in response to the examiner's rejection.

In view of above amendments and the following remarks, reconsideration of the application is respectfully requested.

**Claim Construction**

Although the patent describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification of a patent into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious

“invention” may be used to refer to the technical subject matter that has been invented; the term “invention” may be used to refer to subject matter which is nonobvious; and the term “invention” may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present patent uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the patent using the sentence “As used herein, the term ‘\_\_\_\_\_’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present patent (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the patent, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“the claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

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modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

**Discussion of the Rejections**

The Examiner objected to the specification because the applicant allegedly “improperly uses Trademark items found in the specification on page 8.” Applicant believes that the Examiner was referring to the citation to MicroScents and DigiScents in the paragraph beginning at page 8, line 3. Applicant respectfully points out that MicroScents and DigiScents are the names of companies that, at the time the application was filed, were believed to make the aroma dispensers referred to in that paragraph. Applicant was not misusing Trademarked items in this paragraph, or anywhere else in the specification. For clarity’s sake, and without enlarging the scope of the disclosure, applicant has added some language to the specification regarding the city and state in which applicant believes these companies were located at the time of the filing of the application.

The Examiner rejected claims 7 and 9 as allegedly being indefinite under 35 U.S.C. 112, second paragraph. The Examiner further rejected claims 1-4, 10, 13-15 as allegedly anticipated under 35 U.S.C. 102(b) by Buckely et al. and claims 5, 8, and 16-17 as allegedly anticipated by Webb et al. The Examiner additionally rejected claims 6-7 and 9 as being allegedly unpatentable under 35 U.S.C. 103(a) over Webb et al., claims 18-22 as being allegedly unpatentable over Rysavy et al. in view of Webb et al., and 11-12 and 23-25 as being allegedly unpatentable over Dickinson in view of Rysavy further in view of Webb et al.

All of the foregoing rejections have been mooted by applicant’s cancellation of claims 1-25. Applicant submits herewith claims 26-48, with no admission that claims 1-25 would not have been patentable over the Examiner’s rejection and with no prejudice to refile these claims at a later date. Applicant does have the following comments about Buckely et al., Webb et al., Rysavy et al. and Dickinson.

Buckely et al. and Webb et al. discuss sensor array systems used in the alignment of a raster pattern of a display unit. Applicant submits that Buckely et al. is unclear as to exactly how the system achieves this goal. Webb et al. appears to discuss a system which involves taking a picture of an object in an image on the screen, finding the edges of the object, determining a dimension of the object according to the edges found,

comparing the determined dimension to a reference value and then aligning the raster according to the difference between the dimensions.

Rysavy, by contrast, discusses alignment of a raster pattern with a touch screen. Rysavy has a manual system that relies on the operator to provide manual input which the system uses to correct the alignment of the raster and the touch screen.

By further contrast, Dickinson does not discuss any method of alignment whatsoever, discussing only a gaming machine that has a touch screen associated therewith for user input.

Applicant respectfully submits that none of the patents noted above anticipates claims 26-48 presented herewith. Applicant further submits that the combination of the patents, even as suggested by the examiner in the office action, does not disclose each and every element recited in applicant's claims.

In this regard, applicant notes that the claimed subject matter of claim 26 recites a controller that is programmed to cause a first video image to be generated on said display unit, said first video image including at least one user input area; to cause a second video image to be generated on said display unit, said second video image having a spatial relationship to the at least one user input area of the first video image and including a plurality of regions each having at least one unique characteristic relative to the other regions of the plurality of regions, the plurality of regions with at least one target region; to receive a signal from the sensor associated with the at least one unique characteristic of at least one of the plurality of regions; and, if the signal received from the sensor is not associated with the at least one unique characteristic of the at least one target region, to alter the position of the first and second video images relative to the sensor. These limitations are not to be found in the patents noted above, whether taken individually or in combination.

Similarly, applicant notes that the claimed subject matter of claim 38 recites a method including causing a first video image to be generated on a display unit, said first video image representing a game and including at least one user input area, causing a second video image to be generated on said display unit, said second video image having a spatial relationship to the at least one user input area of the first video image and including a

plurality of regions each having at least one unique characteristic relative to the other regions of the plurality of regions, the plurality of regions with at least one target region, receiving a signal from a sensor associated with the at least one unique characteristic of at least one of the plurality of regions, and altering the position of the first and second video images relative to the sensor, if the signal received from the sensor is not associated with the at least one unique characteristic of the at least one target region. Again, these limitations are not to be found in the patents noted above, whether taken individually or in combination.

Applicant finally notes the Examiner's statement on page 5, that "the games and gaming aspects required by Applicant are considered nominal recitations." The applicant is not aware of the distinction being drawn by the Examiner between "nominal" recitations and other recitations. Applicant is aware of the substantial case law that suggests that to present a prima facie case of anticipation, the examiner must show each and every limitation of the claimed subject matter in a single reference, and that to present a prima facie case of obviousness, the examiner must show, among other things, each and every limitation of the claimed subject matter in a combination of references. In this sense then, all limitations are equal, and the absence of disclosure in a patent or other publication of a given limitation may not be excused by labeling the limitation as "nominal."

### **Conclusion**

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance. If there is any matter that the Examiner would like to discuss, he is invited to contact the undersigned representative at the telephone number set forth below.

Attached hereto is a marked-up version of the changes made to the specification by the current amendment. The attached page is captioned "Version With Markings to Show Changes Made."

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Respectfully submitted,

By 

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**Version With Markings to Show Changes Made**

**In the Specification**

The paragraph beginning at page 8, line 3 has been amended as follows:

The gaming device 20 may include additional features to enhance a user's game-playing experience. For example, one or more audio speakers 46, a sound-generating circuit 48 (Fig. 2) and an aroma dispenser 50 may be positioned on the cabinet 28 as shown in Fig. 1 or in any other suitable location. The audio speakers 46 may provide various sounds relevant to the video gambling game being played on the gaming device 20. For example, the sound-generating circuit 48 may provide electrical signals to the speakers 46 to generate sounds such as the noise of spinning slot machine reels, a dealer's voice, music, announcements or any other desired sounds. The aroma dispenser 50, is shown in Fig. 1 as being mounted above the electronic display device 26 but may be mounted in any other suitable location. Commercially available aroma dispensers, which may be used for the aroma dispenser 50, may be manufactured by MicroScent LLC of Menlo Park, California or DigiScents Inc. of Oakland, California. Of course, any other suitable aroma dispenser made by any other manufacturer may be used instead.